

1 The opinion in support of the decision being entered today was *not* written
2 for publication and is *not* binding precedent of the Board.

3
4 UNITED STATES PATENT AND TRADEMARK OFFICE

5
6
7 BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

8
9 *Ex parte* PETER BRETSCHNEIDER and RUDOLF SCHUSTER
10

11
12 Appeal 2006-3168

13 Application 10/070,824¹

14 Technology Center 3600

15
16 Decided: March 5, 2007
17

18
19 Before HUBERT C. LORIN, ROBERT E. NAPPI and
20 ANTON W. FETTING, *Administrative Patent Judges*.

21
22 HUBERT C. LORIN, *Administrative Patent Judge*.

23
24 DECISION ON APPEAL
25
26

¹Filed 11 March 2002. The real party in interest is Siemens Aktiengesellschaft.

STATEMENT OF THE CASE

The appeal is from a decision of the Examiner rejecting claims 19-27 over the prior art. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6 (b) (2002).

We AFFIRM.

Appellants, in the Brief², argue that the claims stand or fall together. Pursuant to the rules, the Board selects representative claims 19 and 24 to decide the appeal. 37 CFR § 41.37(c)(1)(vii) (2005).

Claim 19 reads as follows:

19. An arrangement for organizing flat items of mail, in accordance with a definable sequence of delivery points assigned to recipient addresses, into a plurality of depositing receptacles into which in each case a plurality of items of mail can be destacked in organized fashion, having a reading arrangement for determining direct or indirect address information located on the items of mail separated by means of separating arrangement, having a plurality of containers which circulate on at least one conveying arrangement and are intended for receiving, for transporting and for discharging in a controllable manner in each case one item of mail into the depositing receptacles in a number of circulating cycles, and having a control arrangement which, with knowledge of the address information of all the items of mail located in the containers, controls the discharge of the items of mail from the containers to the depositing receptacles such that the sequence of the items of mail in a definable order of the depositing receptacles corresponds to the sequence of the delivery

² Our decision will make reference to appellants' Appeal Brief ("Brief," filed 7 July 2004) and to the examiner's Answer ("Answer," mailed 10 November 2004).

1 points assigned to the addresses, the order of the items of mail in each
2 depositing receptacle corresponding to the sequence of the delivery
3 points assigned to the addresses of the items of mail located in the
4 respective depositing receptacle,
5 characterized in that the depositing receptacles are arranged along the
6 conveying arrangement, and in that the depositing receptacles are
7 subdivided into two more or less equally sized groups and, in the case
8 of organizing sorting runs proceeding one after the other, the items of
9 mail of different address areas are alternately sorted only into one of
10 the two depositing-receptacle groups.
11

12 Claim 24 reads as follows:

13
14 24. A process for organizing flat items of mail, in
15 accordance with a definable sequence of delivery points assigned to
16 the recipient addresses, into a plurality of depositing receptacles into
17 which in each case a plurality of items of mail are destacked in
18 organized fashion, in the case of which direct or indirect address
19 information located on the separated items of mail is read, in each
20 case one item of mail is received into one of a plurality of containers
21 circulating on at least one conveying arrangement, is transported
22 therein and is discharged in a controlled manner into the depositing
23 receptacles in a number of circulating cycles, it being the case that,
24 with knowledge of the address information of all the items of mail
25 located in the containers, said items of mail are discharged the
26 containers to the depositing receptacles such that the sequence of the
27 items of mail in a definable order of the depositing receptacles
28 corresponds to the sequence of the delivery points assigned to the
29 addresses, and it being the case that the order of the items of mail in
30 each depositing receptacle corresponds to the sequence of the
31 delivery points assigned to the addresses of the items of mail located
32 in the respective depositing receptacle, characterized in that the
33 depositing receptacles are arranged along the conveying arrangement

1 and are subdivided into two more or less equally sized groups and, in
2 the case of organizing sorting runs proceeding one after the other, the
3 items of mail of different address areas are alternately sorted only into
4 one of the two depositing-receptacle groups.
5

6 ISSUES

7
8 The issue on appeal is whether Appellants have shown that the
9 Examiner erred in concluding that a prima facie case of anticipation is made
10 by Jones' disclosure of a sorting apparatus and method identical to that
11 claimed.

12 FINDINGS OF FACT

13
14 The following findings of fact (FF) are believed to be supported by at
15 least a preponderance of the evidence. To the extent any finding is a
16 conclusion of law, it may be treated as such.

17 1. The invention is directed to an apparatus and process for organizing
18 flat items of mail according to a definable sequence of delivery points
19 assigned to recipient addresses.

20 2. The examiner finally rejected claims 19-27 as being unpatentable
21 under 35 U.S.C. § 102(e) over Jones (see Answer 3).

1 3. U.S. Patent 6,227,378 B1 (“Jones”) issued on 8 May 2001 on an
2 application filed on 24 March 1999 and therefore qualifies as prior art under
3 35 U.S.C. §§ 102 (a) and (e).³

4 4. The Examiner has made a limitation-by-limitation analysis of the
5 claims, finding Jones expressly or inherently discloses each and every
6 limitation and, accordingly, has reached the initial determination that Jones
7 anticipates the claimed subject matter. Answer 3-6.

8 5. In rebuttal to the Examiner’s prima facie case, appellants make the
9 following arguments:

10 (a) In Jones ... “mail item ‘groups’ are not predefined; [] mail item
11 groups are dynamic and subject to change.” Br 9.
12

13 (b) “In Jones ... mail items are not sorted by delivery order sequence
14 because [] mail is received en-mass making sequential group
15 handling impossible [and] mail is sorted by output receptacle volume
16 rather than destination address order.” Br. 9.
17

18 (c) “In Jones ... focus is on maximizing use of output receptacle holding
19 volume [rather than increasing throughput].” Br. 9.
20

21 (d) “In Jones ... output receptacles are not divided into two substantially
22 equal sets ... one mail item group at a time is assigned to all of the
23 output receptacles.” Br. 9.
24

25 (e) Jones does not alternately sort items of mail of different address areas
26 only into one of the two depositing-receptacle groups. Br. 11.
27

³ Jones is applicable as prior art under § 102(a) as well as under § 102(e).
See In re Moore, 170 USPQ 260, 266 (C.C.P.A. 1971). Appellants do not
challenge Jones’ qualifications as prior art.

1 (f) Jones does not organize sorting runs proceeding one after the other.
2 Br. 10.

3 6. Responding to argument 5(a), *supra*, the Examiner argues that
4 the claims do not mention “mail item ‘groups’” or predefining them.
5 Answer, 7.

6 7. We find that the claims do not recite “mail item ‘groups’” or
7 predefining them.

8 8. Responding to argument 5(b), the Examiner argues that Jones
9 discloses sorting items of mail by destination. Answer 8.

10 9. We find that Jones discloses sorting by destination, including setting
11 the sorting priority by destination. See, for example, col. 3, ll. 26-30 and col.
12 5, ll. 2-7.

13 10. Responding to argument 5(c), the Examiner argues that Jones also
14 teaches increasing throughput but that the claims are nevertheless not
15 limited to increasing throughput, citing col. 6, ll. 2+. Answer 9.

16 11. Responding to argument 5(d), the Examiner argues that Jones
17 discloses subdividing the depositing receptacles into two more or less
18 equally-sized groups. Answer 10.

19 12. We find that Jones (col. 6, ll. 8-16) discloses receptacles taking the
20 form of deep trays equally-sized to hold around 40 mail items.

21 13. We find that Jones (col. 3, ll. 31-38) discloses that each receptacle is
22 assigned a mail group; each mail group being a group of mail items intended
23 for a single destination.

24 14. Arguments 5(e) and (f) are directed to the phrase, recited in the
25 claims, “in the case of organizing sorting runs proceeding one after the

1 other, the items of mail of different address areas are alternately sorted only
2 into one of the two depositing-receptacle groups.”

3 15. Responding to arguments 5(e) and (f), the Examiner argues that Jones
4 discloses the case of organizing sort runs proceeding one after the other and
5 items of mail of different address areas are alternately sorted only into one
6 of the two depositing receptacles, citing col. 5, ll. 64+. Answer, p. 10.

7
8 PRINCIPLES OF LAW

9
10 1. A claim is anticipated under 35 U.S.C. §102 “if each and every
11 limitation is found either expressly or inherently in a single prior art
12 reference.” *Bristol-Myers Squibb Co. v. Ben Venue Labs, Inc.*, 246 F.3d
13 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001).

14 2. “The *prima facie* case is a procedural tool of patent examination,
15 allocating the burdens of going forward as between examiner and applicant.
16 *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir.
17 1990). The term “*prima facie* case” refers only to the initial examination
18 step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed.Cir.
19 1984); *In re Rinehart* , 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA
20 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden,
21 on review of the prior art or on any other ground, of presenting a *prima*
22 *facie* case of unpatentability. If that burden is met, the burden of coming
23 forward with evidence or argument shifts to the applicant.” *In re Oetiker*,
24 977 F.2d, 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

1 3. “Claims are given the broadest reasonable construction consistent
2 with the specification.” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d
3 1023, 1027 (Fed. Cir. 1997).

4 4. “The problem is to interpret claims “in view of the specification”
5 without unnecessarily importing limitations from the specification into the
6 claims.” *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67
7 USPQ2d 1947, 1950 (Fed. Cir. 2003).

8
9 ANALYSIS

10
11 The Examiner has made a limitation-by-limitation analysis of the
12 claims, finding Jones expressly or inherently discloses each and every
13 limitation. Based on the analysis, the Examiner has reached the initial
14 determination that Jones anticipates the claimed subject matter. FF 4. The
15 burden now shifts to Appellants to come forward with evidence or argument
16 showing error in Examiner’s determination.

17 Appellants argue that Jones does not teach predefined mail item
18 groups. FF 5(a). But the claims make no mention of predefined mail item
19 groups. FF7. Appellants do not point to any language in the claims limiting
20 the sorting apparatus and method to predefined mail item groups, nor do we
21 find any such language. Accordingly, this argument is not commensurate
22 in scope with what is claimed and the prima facie case remains unaffected.
23 FF 4. *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982) (“Many
24 of appellants’ arguments fail from the outset because ... they are not based
25 on limitations appearing in the claims ...”).

1 Appellants further argue that Jones does not sort mail by delivery
2 order sequence. FF 5(b). Claims are given the broadest reasonable
3 construction consistent with the specification. The instant claims do not
4 define the order of delivery for the items of mail and the specification
5 attaches no particular order of delivery to the phrase “the order of the items
6 of mail in each depositing receptacle corresponds to the sequence of the
7 delivery points assigned to the addresses of the items of mail” set forth in
8 the claims. While the specification exemplifies various sorting sequences
9 based on delivery points (see p. 8), limiting the claims to sorting by any
10 particular delivery order sequence would be impermissibly reading a
11 limitation from the specification into the claims. When given the broadest
12 reasonable construction consistent with the specification, the phrase “the
13 order of the items of mail in each depositing receptacle corresponds to the
14 sequence of the delivery points assigned to the addresses of the items of
15 mail” set forth in the claims requires no more than depositing the items of
16 mail in the receptacles according to their destination of delivery. Jones
17 discloses such an arrangement. FF 9.

18 Appellants further argue that Jones focuses on maximizing use of
19 output receptacle holding volume, FF 5(c), in effect arguing that their
20 invention is directed to an intended use different from that of Jones.
21 However, Appellants point to no positive step set forth in the method claims
22 nor a structural element in the apparatus claims that would distinguish them
23 over the method and apparatus Jones discloses.

24 Appellants further argue that Jones does not divide the output
25 receptacles into two substantially equal sets. FF 5(d). According to the

1 instant claims, the “depositing receptacles ... are subdivided into two more
2 or less equally sized groups.” Based on its plain meaning as understood by
3 one of ordinary skill in the art, the depositing receptacles are subdivided
4 into two groups by assignation, i.e., receptacles are assigned to one of two
5 groups, each group being of equal size. That understanding is consistent
6 with the specification, which explains that

7 [i]f the depositing receptacles 2 are combined into two essentially
8 equally sized groups, which are each assigned a separate address area
9 for which items of mail 3 are to be organized, then it is
10 simultaneously possible for items of mail 3 for a given address area to
11 be deposited in the depositing receptacles 2 of one group while items
12 of mail 3 are still located in the depositing receptacles of the other
13 group, which latter items of mail were previously deposited therein
14 and can now be removed.

15
16 Specification 9. Also, the claims do not specify the number of receptacles
17 to be assigned to the two groups. Therefore a group may consist of a single
18 receptacle. Accordingly, giving it the broadest reasonable construction
19 consistent with the specification, the phrase “depositing receptacles ... are
20 subdivided into two more or less equally sized groups” encompasses a step
21 of assigning two equally sized receptacles to two different groups such that
22 each of the two groups consists of one of the two equally-sized receptacles.
23 Jones discloses such an arrangement. FF 12-13.

24 Lastly, relying on the following clause in the claims:

25 ... in the case of organizing sorting runs proceeding one after the
26 other, the items of mail of different address areas are alternately
27 sorted only into one of the two depositing-receptacle groups,
28

1 Appellants argue that Jones does not organize sorting runs proceeding one
2 after the other (FF 5(d)) and alternately sorting items of mail of different
3 address areas only into one of the two depositing-receptacle groups (FF
4 5(e)). But Appellants' argument is premised on reading the claims as limited
5 to an arrangement/method operating per the instructions set forth in the
6 clause. However, the clause is not preceded by any step or structure
7 conditioned on a step of organizing sorting runs proceeding one after the
8 other. The clause is not worded so as to require the scenario it describes to
9 be an additional step or function to the method/apparatus otherwise claimed.
10 Nor does the specification define the phrase "in the case of" to mean
11 anything but an exemplification of the invention. The specification
12 describes a number of possible arrangements applying the invention – one
13 of which (9, ll. 19-28: "If the ...") resembles the scenario the clause
14 describes. Accordingly, the broadest reasonable construction of the phrase
15 "in the case of" consistent with the specification is that it connotes an option
16 for the claimed subject matter's intended use; in other words, items of mail
17 of different address areas are alternately sorted only into one of the two
18 depositing-receptacle groups if one were to decide to organize sorting runs
19 proceeding one after the other. As an "option", the clause language does
20 not limit the scope of claimed subject matter so as to narrow the claimed
21 subject matter to "organizing sorting runs proceeding one after the other."
22 *Cf. Ex parte Cordova*, 10 USPQ2d 1949, 2033 (Bd. Pat. App. & Int'f 1988)
23 ("each case must be decided on its own facts. In this case, the term
24 'optionally' clearly indicates that the polyamine may, or may not, be present
25 as a fourth component in the, otherwise, three component composition.").

1 Also, to organize sorting runs proceeding one after the other and to
2 alternately sort items of mail of different address areas only into one of the
3 two depositing-receptacle groups necessarily requires sorting such that the
4 depositing receptacles are separately assigned mail for different
5 destinations, an arrangement Jones discloses, i.e., wherein two depositing-
6 receptacle groups are separately assigned mail for different destinations (FF
7 13.). Accordingly, Jones inherently discloses an apparatus operating per “in
8 the case of” clause scenario.

9 For both these reasons, Appellants’ argument that the claimed subject
10 matter distinguishes from Jones because Jones does not organize sorting
11 runs proceeding one after the other and alternately sorting items of mail of
12 different address areas only into one of the two depositing-receptacle groups
13 is not persuasive as to error in the rejection.

CONCLUSION OF LAW

On the record before us, the Examiner's evidence and rationale is sufficient to make out a prima facie case of anticipation under 35 U.S.C. § 102(e). On the record before us, Appellants have not shown that the Examiner erred in concluding that a prima facie case of anticipation is made by Jones' disclosure of a sorting apparatus and method identical to that claimed.

DECISION

The Examiner's rejection of claims 2, 3, 8-10, 15-17, 22-24 and 29 is affirmed.

